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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/522,006

01/14/2005

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EXAMINER

JOY, DAVID J

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

12/26/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/522,006	<b>Applicant(s)</b> PONCELET ET AL.	
	<b>Examiner</b> David J. Joy	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-3 and 5-19 are pending as amended on September 12, 2008, with Claim 4 having been cancelled.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Response to Amendment***

3. Applicant's amendments to Claims 1 and 2, and the corresponding cancellation of Claim 4, in the amendment filed on September 12, 2008 obviates the previously cited rejections under 35 U.S.C. §112. The rejection of Claims 1-19 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement, has been withdrawn. Likewise, the rejection of Claims 1-19 under 35 U.S.C. §112, second paragraph, as being indefinite, has been withdrawn.

4. Applicant's cancellation of Claim 4, in the amendment filed September 12, 2008, renders the previously cited rejection under 35 U.S.C. §102 moot. Therefore, the

rejection of Claim 4 under 35 U.S.C. §102(e) as being anticipated by the U.S. Patent of Liu et al. (6,548,149; hereinafter "Liu") has been withdrawn.

***Terminal Disclaimer***

5. The terminal disclaimer filed on September 12, 2008 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration dates of Patent Application Nos. 10/521,348, 10/583,528, 10/521,898 and 10/521,899 has been reviewed and is NOT accepted. The terminal disclaimer does not comply with 37 CFR 1.321(b) and/or (c) because:

The application/patent being disclaimed has been improperly identified since the numbers used to identify the pending patent applications being disclaimed are incorrect. The correct numbers appear hereinabove.

***Claim Rejections - 35 USC § 102***

6. Claims 1-3 and 5-19 stand rejected under 35 U.S.C. 102(e) as anticipated by Liu.

7. Liu teaches an ink jet recording element that contains a support and at least one ink-receiving layer (see Abstract; see also Column 5, Lines 33-53; see also Column 6, Lines 18-28). In addition, Liu teaches that the ink-receiving layer comprises a hydrosoluble binder (i.e., polyvinyl alcohol) and an aluminosilicate polymer that is

dispersed in the binder matrix (see Column 5, Lines 33-53; see also Column 6, Lines 18-28; see also Column 9, Lines 44-60; see also Column 10, Lines 46-56). Specifically, Liu provides that the aluminosilicate polymer that is present in the ink-receiving layer is such that it has an Al/Si molar ratio between 1 and 4 (see Column 9, Lines 44-60). In addition, Liu recites that the ink receiving layer, after printing, contains an amount of aluminosilicate particles that is from 50 to 100% by weight of the ink receiving layer and the additional ink-absorbent layer, which clearly meets the broad recitation of an amount between 5 and 95%, as in the present claim (see Column 15, Lines 42-57). In combining the aluminosilicate polymer with the suitable binder, it follows that Liu also provides that a coating composition for the ink-receiving layer is thus obtained.

8. Claims 1-3 and 5-16 are viewed as product-by-process claims and hence the methods that the aluminosilicate is created by are not pertinent, unless applicant can show a different product is produced, despite that fact that Liu recites that the inclusion of the aluminosilicate in the ink-receiving layer results in an ink jet recording material that has a high gloss, produces high quality printed images and has a good dye keeping time. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the

product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.”

*In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

10. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

11. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1-3, 5-12, 14-16 and 19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-3 and 5-18 of copending Application No. 10/521,348. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter dealing with the aluminosilicate polymer's production that is claimed in the instant application is fully disclosed in the copending application and would be covered by any patent granted on that copending application since the claims found in both the copending application and the instant application are claiming common subject matter, as follows: a polymer obtainable by a method for preparing aluminosilicate polymer

comprising steps for treating a mixed aluminum and silicon alkoxide comprising only hydrolyzable functions in the presence of silanol, stirring the mixture in the presence of silanol groups until a polymer is formed, and eliminating the byproducts from the reaction medium. Since the scope of the instant claims and the scope of the claims in the copending application are overlapping, the claimed subject matter of the instant claims is not patentably distinct over the claims of the copending application.

13. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14. Claims 1-3 and 5-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-17 of copending Application No. 10/583,528. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter that is claimed in the instant application dealing with an ink jet recording material containing an aluminosilicate polymer that is produced according to a particular method is fully disclosed in the copending application. The sole difference between the claims of the instant application and those of the copending application has to do with the molar ratio of a chelating agent that optionally added to the invention of the



instant application. However, such a variation is clearly a parameter that a skilled artisan could alter in order to obtain the optimal performance from the ink jet recording material that exhibits the following properties: high quality printed images, rapid drying after printing, good dye keeping in time, smooth appearance, and high gloss.

15. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

16. Claims 1-3 and 5-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-3, 5-10, and 16-25 of copending Application No. 10/521,898. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter that is claimed in the instant application pertaining to an ink jet recording material containing an aluminosilicate polymer that is produced according to a particular method is fully disclosed in the copending application. While the claims of the copending application recite all of the same limitations as those of the instant application, the copending claims also recite the addition of non-hydrolyzable functional groups of silicon compounds. However, given the broad recitation and open-ended language of the instant claims, it would have been obvious to a skilled

artisan to be able to modify a hybrid polymeric solution and make a polymer having only hydrolysable functional groups. Further, the copending application also recites that the relative ratio of the hydrolyzable functional groups and the non-hydrolyzable functional groups can be so low (i.e., as low as 0.1), that the hybrid polymer would practically match the polymer having only hydrolyzable groups in its overall composition. Likewise, such a variation is clearly a parameter that a skilled artisan could vary in order to obtain the optimal performance from the ink jet recording material that exhibits the following properties: high quality printed images, rapid drying after printing, good dye keeping in time, smooth appearance, and high gloss.

17. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

18. Claims 1-3, 5-12, 14-16 and 19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-8, 10-11 and 17-22 of copending Application No. 10/521,899. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter dealing with the aluminosilicate polymer's production that is claimed in the instant application is fully disclosed in the copending application and would be

covered by any patent granted on that copending application since the claims found in both the copending application and the instant application are claiming common subject matter, as follows: a polymer obtainable by a method for preparing aluminosilicate polymer comprising steps for treating a mixed aluminum and silicon precursor resulting from the hydrolysis of a mixture of aluminum compounds and silicon compounds only having hydrolyzable substituents in the presence of silanol, stirring the mixture in the presence of silanol groups until a polymer is formed, and eliminating the byproducts from the reaction medium. Since the scope of the instant claims and the scope of the claims in the copending application are overlapping, the claimed subject matter of the instant claims is not patentably distinct over the claims of the copending application. While the claims of the copending application recite all of the same limitations as those of the instant application, the copending claims also recite the addition of non-hydrolyzable functional groups of silicon compounds. However, given the broad recitation and open-ended language of the instant claims, it would have been obvious to a skilled artisan to be able to modify a hybrid polymeric solution and make a polymer having only hydrolysable functional groups. Further, the copending application also recites that the relative ratio of the hydrolyzable functional groups and the non-hydrolyzable functional groups can be so low (i.e., as low as 0.1), that the

hybrid polymer would practically match the polymer having only hydrolyzable groups in its overall composition.

19. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

20. As for the citations to the teachings contained in the specifications of the copending applications cited to hereinabove, Applicant's attention is drawn to MPEP 804 where it is disclosed that "the specification can always be used as a dictionary to learn the meaning of a term in a patent claim." *In re Boylan*, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968). Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent (underlining added by examiner for emphasis). *In re Vogel*, 422 F.2d 438, 164 USPQ 619, 622 (CCPA 1970). Consistent with the above underlined portion of the MPEP citation, the aforementioned references to the specifications of the instant applications are proper.

*Response to Arguments*

21. Applicant's arguments filed September 12, 2008 have been fully considered but they are not persuasive.

22. Applicant argues that Liu does not disclose, teach or suggest an aluminosilicate polymer obtained by the preparation method claimed. However, it is noted that Applicant's assertions are insufficient as they must show objective evidence of the claimed process, the process taught in the reference, and a clear showing of how the claimed process renders the final product that is obtained different and patentably distinct from that which is obtained in the reference. While Applicant points to Comparative Example 1 and Comparative Example 5 in the present specification, the data is not persuasive given that it does not compare the present invention with the Liu reference. There is no evidence that the product produced by the process of Liu is different than that which is presently claimed.

23. Although Liu does not disclose that the aluminosilicate polymer is obtained by the preparation method that is presently claimed, it is noted that "[E]ven though product-by-process claims are limited by and defined by the process, determination of

patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process", *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Further, "although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product", *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). See MPEP §2113.

Therefore, absent clear evidence of criticality regarding the presently claimed process and given that Liu meets the requirements of the claimed ink jet recording element, Liu clearly meet the requirements of Claims 1-3 and 5-19.

24. Applicant also states that a terminal disclaimer was filed to overcome the double patenting rejections. The status of the terminal disclaimer and the rejections of the claims on the grounds of nonstatutory obviousness-type double patenting have been addressed hereinabove.

*Conclusion*

25. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

26. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Joy whose telephone number is (571) 272-9056. The examiner can normally be reached on Monday - Friday, 7:00 AM - 3:30 PM EST.

28. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie E. Shosho can be reached on (571) 272-1123. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

29. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DJJ/  
Examiner, Art Unit 1794  
12/15/2008

/Callie E. Shosho/  
Supervisory Patent Examiner, Art Unit 1794